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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. BARRETT,
ANNA M. GRANO,
and LAWRENCE R. MAIER

Appeal 2009-000707
Application 09/882,148
Technology Center 3600

Decided: December 4,2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert L. Barrett, Anna M. Grano, and Lawrence R. Maier (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-13, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION[1]

We AFFIRM.

THE INVENTION

The Appellants invented a way of delivering integrated system solutions (Specification 1:3-4).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of business engagement, comprising the steps of:
[1] defining an engagement model
which will be used to address a marketplace requirement;
[2] thereafter using said engagement model

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed July 24, 2007) and the Examiner's Answer ("Answer," mailed December 26, 2007).

to create an industry- wide engagement template applicable to all businesses in said marketplace;

[3] modifying said industry-wide engagement template

to address requirements of a specific client within said marketplace; and

[4] thereafter measuring, monitoring, and controlling a client engagement

based upon said modified industry-wide engagement template.

THE REJECTION

The Examiner relies upon the following prior art:

Young	US 6,915,270 B1	Jul. 5, 2005
Barnes	US 6,950,802 B1	Sep. 27, 2005

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Young and Barnes.

ARGUMENTS

The Appellants argue these claims as a group. Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Appellants contend that the art fails to describe using an engagement model to create an industry-wide engagement template applicable to all businesses in said marketplace (App. Br. 5: First full ¶).

ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Young and Barnes turns on whether using an

engagement model to create an industry- wide engagement template applicable to all businesses in a marketplace was predictable.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Young

01. Young is directed to a business method focused on profitable customer relationships, based on a combination of the CRM, BI and CVM competencies, and includes (a) construction of an engagement model, followed by (b) phases, (c) activities, (d) tasks, (e) generation of work products, and (f) generation of technique papers. Young 1:62 – 2:2.

02. Young includes: repeatable engagement models; engagement templates containing instances of best practices and benchmarking data; focused activities that leverage business intelligence, CRM and CVM competencies that produce a customer management result for profitable, loyal relationships; a work breakdown structure that decomposes a series of complex tasks to support the customer-centric approach and its use of CVM techniques and best practices; and the use of examples, *templates* and technique papers. Young 2:59 – 3:5.

03. Among Young's tools are: an automated environment for downloading engagement models and their associated engagement

templates to the engagement teams (at the end of each engagement, this environment will also be able to upload the engagement team's work for intellectual capital harvesting and hardening purposes); automated tools used by the data framework to test hypotheses; and visual tools for automating the mapping and comparing of a client's existing and desired capabilities, with reference to "best practices". Young 3:6-20.

04. Young uses benchmarking data and industry best practices to provide industry-specific criteria for measuring performance and is based upon repeatable and reusable engagement models. Young 3:28-33.

Barnes

05. Barnes is directed to the professional service of delivering integrated system solutions. Barnes 1:7-8.

06. Barnes defines market initiatives and offerings using models and template components which are responsive and flexible to an ever-changing marketplace. Barnes 1:50-53.

07. Barnes provides an engagement family that includes an engagement model definition. Barnes 3:48-51. This model is used to address a marketplace requirement; and this engagement model is used to create an engagement template which specifically addresses client requirements within the marketplace. Client engagements are then measured, monitored and controlled based upon the engagement model. Barnes 2:17-24.

Facts Related To The Level Of Skill In The Art

08. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, professional services engagement management, or document processing. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

09. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and

the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." *Graham,* 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416.

ANALYSIS

The Appellants argue the art fails to describe using an engagement model to create an industry- wide engagement template applicable to all businesses. The remaining limitations of defining an engagement model; using that engagement model to create an engagement template; modifying the engagement template to address requirements of a specific client; and thereafter measuring, monitoring, and controlling a client engagement based upon the engagement template are not in dispute.

This is hardly surprising since the whole purpose of an engagement letter is to address requirements of a specific client and thereafter measure, monitor, and control the client engagement based upon the engagement letter. This purpose and use of an engagement letter is not in dispute. Further, Young and Barnes describe this use of an engagement letter. FF 01-04, and 07. The use of a template per se is not in dispute. Barnes explicitly recites the use of a template for engagement letters. FF 05-07.

Thus the sole issue before us is whether it was predictable to use an industry-wide engagement template applicable to all businesses in said marketplace. The Examiner took Official Notice of the prevalence of this practice with templates in general, *i.e.* the modification of templates according to the marketplace. Answer 4. The Examiner found that Barnes

explicitly recited creating a model, *i.e.* a template, that addresses generic marketplace requirements and using that model to create an engagement template that specifically addresses client requirements within a specific marketplace. Answer 6. The Examiner also found that Appellants have argued limitations described in the Specification that were not in the claims, responding that limitations from the Specification are not imported into the claims. *Id.*

We agree with the Examiner that the whole point of a template is to modify it as it is applied to a particular purpose. We also agree that Barnes describes a marketplace wide engagement model that is derived from an engagement family applicable across markets. FF 07. Thus, Barnes' family corresponds to the claim model; Barnes' model corresponds to the claim template; and Barnes' template and project are a two tier example of the claim engagement. This market wide model or template in Barnes suggests the use of an industry-wide engagement template applicable to all businesses in a marketplace.

We further find that the limitation in claim 1 of an industry-wide engagement template applicable to all businesses in a marketplace does not narrow the contents of such a template, but only specifies the use to which such a template might be made. At most it might require the absence of content as to a specific industry, although since the template is to be modified, any such content could be deleted. But keeping a format lean in a template to accommodate changes is hardly new or unknown. Certainly the ultimate, albeit minimalist lean template, an 8 ½ x 11 blank sheet of paper, is an industry wide template that can be used for all businesses. But more pointedly, Barnes' model or template that exists prior to its use to create a

more narrowly tailored template implies an absence of a specific industry in its content prior to such narrowing. Thus we find the Appellants' arguments unpersuasive.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Young and Barnes.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Young and Barnes is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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